

Applicants: White et al.
Serial No.: 10/761,883
Filing Date: January 20, 2004
Docket No.: EGT-007-1C

REMARKS

Reconsideration and allowance are respectfully requested. Before entry of this response, claims 1-20 were pending. In the Office Action, claims 1-20 were rejected. In the present response, no claims are amended, added or canceled. After entry of this response, claims 1-20 are pending.

I. Claims 1-5, 7, 9, 11, 14, and 16-19

Claims 1-5, 7, 9, 11, 14, and 16-19 are rejected under 35 U.S.C. § 102(e) as being anticipated by Donaldson (U.S. Pat. 7,249,175) (Office Action, p. 4, lines 6-7).

A. Independent claims 1 and 14

Claim 1 recites, "whereby MTA_1 controls the interaction between MTA_0 and MTA_1 before a RCPT command from MTA_0 is received by the unsolicited message rejecting communications processor" (emphasis added). Claim 14 recites, "allowing MTA_1 to control the interaction between MTA_0 and MTA_1 until a RCPT reply is received from MTA_0" (emphasis added).

The issue is whether the MTA_1 of Donaldson "controls the interaction between MTA_0 and MTA_1 before a RCPT command from MTA_0 is received". Donaldson does not form the basis for a valid rejection of either claim 1 or claim 14 under § 102(e) because Donaldson does not teach allowing MTA_1 to control the interaction between MTA_0 and MTA_1 up until the point where a RCPT message is received from MTA_0.

The passages of Donaldson cited by the Examiner (Office Action, p. 5, line 22 – p. 6, line 2) do not teach when MTA_1 takes control of "the connection" in the event of an email message, except for the last citation (Donaldson, column 36, lines 6-15). Donaldson (col. 3, lines 51-60) discusses a conventional SMTP message transfer scenario between MTA_0 and MTA_1 that does not include an "unsolicited message rejecting communications processor" of any sort.

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Donaldson (col. 8, lines 21-24) discusses "an email filter that operates at the MTA level and performs active filtering based upon characteristics of the incoming connection and the remote host", but this does not address when MTA_1 "controls the interaction between MTA_0 and MTA_1". Donaldson (col. 9, lines 19-27) discusses that "the proxy offloads the rejection of junk mail, so that the MTA need only consider legitimate email", but this does not address when MTA_1 "controls the interaction between MTA_0 and MTA_1".

Donaldson (col. 14, lines 5-22 and col. 17, lines 45-54) discusses multiple embodiments of "active filtering" technology, but does not address when MTA_1 "controls the interaction between MTA_0 and MTA_1". Donaldson (col. 36, lines 6-15) discloses, however, that two "tests" (features) defer (ie. wait) to RCPT time because information necessary for these tests is not available until RCPT time. The other features do not wait until RCPT time. Therefore, MTA_1 cannot be "controlling" the interaction before RCPT time because, if that were the case, then the other features could not be "controlling" the connection to perform their "tests". Therefore Donaldson, if anything, teaches away from the claimed invention and suggests waiting to do tests only if necessary.

Donaldson (col. 36, lines 6-15) suggests that the only reason the two tests are deferred is because they require information not available until the RCPT time. Therefore, Donaldson suggests that the tests be performed as early as possible. Claim 1 on the other hand, recites that MTA_1 always "controls the interaction between MTA_0 and MTA_1 before a RCPT command from MTA_0 is received". The system of Donaldson, however, always takes control of the connection immediately upon establishment of the TCP/IP connection to the "communications processor". Some tests (features) are delayed, but others are not.

Because Donaldson does not teach that MTA_1 controls the interaction between MTA_0 and MTA_1 before or until a RCPT command from MTA_0 is received, reconsideration of the § 102(e) rejection and allowance of claims 1 and 14 are requested.

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B. Dependent Claims 2-5, 7, 9, and 11

Claims 2-5, 7, 9 and 11 depend directly or indirectly from claim 1 and include the following limitation from claim 1: “whereby MTA_1 controls the interaction between MTA_0 and MTA_1 before a RCPT command from MTA_0 is received by the unsolicited message rejecting communications processor” (emphasis added).

As explained above with regard to claim 1, Donaldson does not teach the recited limitation relating to control by MTA_1 “before a RCPT command from MTA_0 is received”. For at least the same reasons for which claim 1 is allowable, claims 2-5, 7, 9 and 11 are allowable. Reconsideration of the § 102(e) rejection and allowance of claims 2-5, 7, 9 and 11 are requested.

C. Dependent Claims 16-19

Claims 16-19 depend from claim 14 and include the following limitation from claim 14: “allowing MTA_1 to control the interaction between MTA_0 and MTA_1 until a RCPT reply is received from MTA_0” (emphasis added).

As explained above with regard to claim 14, Donaldson does not teach the recited limitation regarding control by MTA_1 “until a RCPT reply is received from MTA_0”. For at least the same reasons for which claim 14 is allowable, claims 16-19 are allowable. Reconsideration of the § 102(e) rejection and allowance of claims 16-19 are requested.

II. Claims 6, 8 10, 12-13, 15 and 20

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Donaldson in view of Andrews (U.S. Pat. Pub. 2003/0204569) (Office Action, p. 12, lines 12-14). Claims 8, 10 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Donaldson in view of Wilson (U.S. Pat. Pub. 2004/0015554) (Office Action, p. 13, lines 11-13). Claims 12-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Donaldson in view of Levosky (U.S. Pat. Pub. 2002/0087641) (Office Action, p. 15, lines 1-3). Claim

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15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Donaldson, Andrews, Levosky and Wilson and in further view of Postel (RFC 821, Simple Transfer Protocol) (Office Action, p. 16, lines 19-21).

A. Dependent Claims 6, 8, 10 and 12-13

Claims 6, 8, 10 and 12-13 depend from claim 1 and include the following limitation from claim 1: “whereby MTA_1 controls the interaction between MTA_0 and MTA_1 before a RCPT command from MTA_0 is received by the unsolicited message rejecting communications processor” (emphasis added).

As explained above, Donaldson does not disclose or teach “whereby MTA_1 controls the interaction between MTA_0 and MTA_1 before a RCPT command from MTA_0 is received by the unsolicited message rejecting communications processor” (emphasis added). Moreover, none of the other references cited in support of the rejections of claims 6, 8, 10 and 12-13 discloses “whereby MTA_1 controls the interaction between MTA_0 and MTA_1 before a RCPT command from MTA_0 is received by the unsolicited message rejecting communications processor”. Consequently, no combination of Donaldson and any of the cited references teaches “whereby MTA_1 controls the interaction between MTA_0 and MTA_1 before a RCPT command from MTA_0 is received by the unsolicited message rejecting communications processor”. For at least the same reasons for which claim 1 is allowable, claims 6, 8, 10 and 12-13 are allowable. Reconsideration of the § 103(a) rejection and allowance of claims 6, 8, 10 and 12-13 are requested.

B. Dependent Claim 20

Claim 20 depends from claim 14 and includes the following limitation from claim 14: “allowing MTA_1 to control the interaction between MTA_0 and MTA_1 until a RCPT reply is received from MTA_0” (emphasis added).

As explained above, Donaldson does not teach “allowing MTA_1 to control the interaction between MTA_0 and MTA_1 until a RCPT reply is

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received from MTA_0" (emphasis added). Moreover, none of the other references cited in the last Office Action discloses "allowing MTA_1 to control the interaction between MTA_0 and MTA_1 until a RCPT reply is received from MTA_0". Consequently, no combination of Donaldson and any of the cited references teaches "allowing MTA_1 to control the interaction between MTA_0 and MTA_1 until a RCPT reply is received from MTA_0". For at least the same reasons for which claim 14 is allowable, claim 20 is allowable. Reconsideration of the § 103(a) rejection and allowance of claim 20 are requested.

C. Independent claim 15

Claim 15 recites step r), "relaying the HELO reply from MTA_0 to MTA_1" and step x), "relaying MAIL reply to MTA_1".

Regarding claim 15, the Examiner notes:

"regarding steps r) and x), the combined teachings of Donaldson, Andrews, Levosky, Wilson, and Postel, *does* disclose relaying any of the commands from MTA_0 to MTA_1 until after the RCPT command where it may operate in pass-through (Donaldson: (col.3, lines 51-60, col.8, lines 21-24, col.9, lines 19-27, col.14, lines 5-22, col.17, lines 45-54, and col.36, lines 6-15)" (Office Action, p. 34, lines 16-20).

Analogous to the argument presented earlier regarding claim 1 and claim 14, the issue is whether the "Active Filtering" of Donaldson simply relays the HELO and MAIL messages to MTA_1, thus permitting MTA_1 to control the interaction with MTA_0 prior to RCPT time. As argued above, the passages of Donaldson cited by the Examiner (Office Action, p. 34, line 19-20) do not teach when MTA_1 takes control of "the connection" in the event of an email message, except for the last citation (Donaldson, col. 36, lines 6-15).

Donaldson (col. 3, lines 51-60) discusses a conventional SMTP message transfer scenario between MTA_0 and MTA_1 that does not include an "unsolicited message rejecting communications processor" of any sort. Donaldson (col. 8, lines 21-24) discusses "an email filter that operates at the

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MTA level and performs active filtering based upon characteristics of the incoming connection and the remote host”, but this does not address when MTA_1 “controls the interaction between MTA_0 and MTA_1”. Donaldson (col. 9, lines 19-27) discusses that “the proxy offloads the rejection of junk mail, so that the MTA need only consider legitimate email”, but this too does not address when MTA_1 “controls the interaction between MTA_0 and MTA_1”. Donaldson (col. 14, lines 5-22 and col. 17, lines 45-54) discusses multiple embodiments of “active filtering” technology, but also does not address when MTA_1 “controls the interaction between MTA_0 and MTA_1”.

Donaldson (col. 36, lines 6-15) states, however, that two “tests” (features) defer (i.e., wait) to RCPT time because information necessary for these tests is not available until RCPT time. The other features do not wait until RCPT time. Therefore, MTA_1 cannot be “controlling” the interaction before RCPT time because if that were the case, then the other features could not be “controlling” the connection to perform their “tests”. Therefore, if anything, Donaldson teaches away from the claimed limitation and suggests waiting to do tests only if necessary.

Donaldson (col. 36, lines 6-15) suggests that the only reason the two tests are deferred is because they require information not available until the RCPT time. Therefore, Donaldson suggests doing testing as early as possible (before RCPT time), and the HELO and MAIL messages are not simply relayed to MTA_1 (see Donaldson figures 18-20).

In addition, none of the other references cited in support of the rejection of claim 15 discloses either “relaying the HELO reply from MTA_0 to MTA_1” or “relaying the MAIL reply from MTA_0 to MTA_1”. Consequently, no combination of Donaldson and any of the cited references teaches either “relaying the HELO reply from MTA_0 to MTA_1” or “relaying the MAIL reply from MTA_0 to MTA_1”.

Because the combination of Donaldson, Andrews, Levosky, Wilson and Postel does not teach the limitations of steps “r)” or step “x)” of claim 15,

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reconsideration of the § 103(a) rejection and allowance of claim 15 are requested.

III. Claims 1-13 and 15

Claims 1-13 (Office Action, p. 3, lines 1-3) and claim 15 (Office Action, p. 3, lines 15-17) are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing particularly to point out and distinctly to claim the subject matter which applicants regard as their inventions.

A. Claims 1-13

Regarding claim 1, the examiner states:

“In this case, the amended whereby clause in claim 1 that recites ‘whereby the connection with MTA_0 is rejected by the intercepting means before the data portion of the unsolicited message is *transmitted*’, raises uncertainties as to whether the connection is rejected before the data portion of the unsolicited message is *transmitted to* the unsolicited message rejecting communications processor or the MTA_1” (Office Action, p. 3, lines 4-9).

The standard for adequacy of claim language under 35 U.S.C. § 112, second paragraph, is whether one skilled in the art would understand what is claimed when read in light of the specification. *Credle v. Bond*, 25 F.3d 1566, 30 USPQ2d 1911 (1994).

Notwithstanding the examiner’s statement, applicants contend that “one skilled in the art” would clearly understand the claim language that simply states “the connection with MTA_0 is rejected by the intercepting means before the data portion of the unsolicited message is transmitted”. No further qualification or specification of potential message destinations is required because “the connection with MTA_0 is rejected . . . before the data portion . . . is transmitted” (emphasis added). If no message is transmitted, it is superfluous to describe

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where the untransmitted message would have been sent. The message is simply not transmitted, as is clearly stated in the claim language.

Applicants respectfully request reconsideration of the § 112, second paragraph, rejection of claim 1 and the same rejection of claims 2-13 based on their dependency on claim 1.

B. Claim 15

Regarding claim 15, the examiner states:

“step w) recites: ‘testing if DD_0 does not match the domain of A_0 and the domain of A_0 is in the suspect_domain database’. There is insufficient antecedent basis for this limitation in the claim.”
(Office Action, p. 3, lines 18-20).

The standard for adequacy of claim language under 35 U.S.C. § 112, second paragraph, is whether one skilled in the art would understand what is claimed when read in light of the specification. *Credle v. Bond*, 25 F.3d 1566, 30 USPQ2d 1911 (1994).

Notwithstanding the examiner’s statement, applicants contend that “one skilled in the art” would clearly understand the claim language “the domain of A_0”. The preceding claim language in claim 15 defines a sender address of A_0. One skilled in the art would recognize that a sender address possesses both an individual identifier and a domain name (e.g., spammer@hotmail.com, where “hotmail” is a domain identifier within the quoted sender address). Furthermore, this is explained in detail in paragraph [0083] of the specification. Therefore, the language of the claimed step w) including “the domain of A_0” has a clear meaning to one skilled in the art and satisfies the requirements set forth in 35 U.S.C. § 112, second paragraph.

Applicants respectfully request reconsideration of the § 112, second paragraph, rejection of claim 15.

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IV. Conclusion

In view of the foregoing remarks, Applicants respectfully submit that the entire application (claims 1-20 are pending) is in condition for allowance. Applicants respectfully request that a timely Notice of Allowance be issued in this case. If the Examiner would like to discuss any aspect of this application, the Examiner is requested to contact the undersigned at (925) 550-5067.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By 
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Date of Deposit: August 30, 2008

Respectfully submitted,



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